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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/769,066 | 05/29/2001 | Thomas R. Fuerst | 4600-0293.20 | 7789 |
| 22918 | 7590 | 04/25/2005 | EXAMINER | |
| PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026 | | | FOLEY, SHANON A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1648 | |

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/769,066

Applicant(s)

FUERST ET AL.

Examiner

Shanon Foley

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

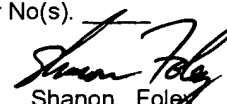
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 25.
Claim(s) withdrawn from consideration: 19-24 and 26-33.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the Note below as well as the attached correspondence.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____


Shanon Foley
Primary Examiner
Art Unit: 1648

Continuation of 3. NOTE: The proposed amendment would require further consideration and search because any nucleic acid that selectively hybridizes to the C-terminal HEV ORF 2 has not been searched or considered previously. Such nucleic acid sequences have not been described and would have to be considered under 35 USC 112, first under written description and/or new matter because applicant has not pointed to support for such nucleic acid concepts .

Request for Reconsideration

It is clearly evident that the single phrase regarding claim 25 on page 6 of the Office action mailed 6/2/4 contradicts the lengthy discussions for reasons why the “70% homologous” language is rejected under 35 USC 112, first paragraph in the preceding pages. There is also clearly identified prior art under 35 USC 102(b) against the claimed nucleic acids with the percent homology. Therefore, the inclusion of such “70% homologous” language in claim 25, presented in the 10/04/04 amendment, would clearly not overcome the rejections of record since the claimed nucleic acids with the recited percent homology are not patentable under 35 USC 112, first and 35 USC 102 (b). The single phrase regarding claim 25 on page 6 of 6/2/4 was an inadvertent typo and the finality of the previous Office action is maintained for reasons of record.

Regarding the sequences disclosed in withdrawn claims 26-33, it is maintained that the inventions are distinct or independent from the elected invention. Each of the sequences in the corresponding SEQ ID NOs of claims 26-33 are structurally and functionally divergent. Each has a different structural sequence and is a different polypeptide. As applicant states, SEQ ID NOs: 13 and 14 are directed at the entire protein encoded by ORF2. However, the instant invention under consideration concerns the C-terminal end of ORF2. Applicant also points out that SEQ ID NOs: 17 and 18 are directed at proteins within ORF2. However, these proteins divergent from the proteins of SEQ ID NOs: 15 and 16 under examination. Due to the uniqueness of each sequence, a non-overlapping and divergent search is required. Further, the method of producing an HEV polypeptide composition of claims 29 and 33 can be practiced with either of the two materially different compositions described in claims 27 or 31. Therefore, the

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inventions are distinct under MPEP § 806.05(f) and the restriction is proper under 37 CFR 1.142(b) and MPEP § 821.03.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanon Foley whose telephone number is (571) 272-0898. The examiner can normally be reached on M-Th 6:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shanon Foley
Primary Examiner
Art Unit 1648